

Appl. No. 10/659,688
Office Action mailed September 22, 2004
Amendment transmitted Monday, January 24, 2005

Attorney Docket 3716/155

REMARKS

1. The application was filed with Claims 1-28, all of which remain pending. In the Office Action, Claims 1, 2, 5-14 and 18-28 were rejected. The Examiner indicated that Claims 3, 4, and 15-17 would be allowable, if rewritten in independent format with all the limitations of the claims from which they depend. The Examiner is thanked for finding allowable subject matter in these claims. Claim 8 has been amended in a non-narrowing manner to correct antecedent basis. Claims 4 and 16 have been amended to better describe the invention. Claims 1, 11 and 23 have been amended to distinguish from the rejections.

Claim 1 has been amended to make it clear that the switch is activated by motion along a vertical axis, and that the finger tapper is also oriented for motion along the axis of the switch. Support for the amendment is found at least in Claim 1 as filed, in Figs. 1-2, and in the specification at para. 31, lines 1-6, and para. 32, lines 1-5 and 7-9. Claim 4 has been amended to be consistent with amended Claim 1. Support for the amendment to Claim 4 is found at least in Claim 4 as filed. Applicants have amended Claim 8 in a non-narrowing manner to correct antecedent basis. Support for the amendment is found at least in the claim as filed.

Claim 11 has also been amended, and finds support for the amendment in Claim 11 as filed, in Fig. 2, and in the same portions of the specification. Claim 16 has been amended to better describe the invention. Support for the amendment is found at least in Claim 16 as filed, and in the specification at para. 20, lines 3-5. Support for the amendment to Claim 23 is found in Claim 23 as filed, in Figs. 1, 2 and 9, and in the specification at para. 31, lines 1-6, and para. 32, lines 1-5 and 7-9.

2. Claims 1, 5-9, 11-14, 18, 20-23, and 25-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Pat. No. 5,540,132 to Beverly Hale ("Hale"). The rejection states that Hale discloses all the limitations of Claim 1, with a speaker being "inherent," except for a computer chip. The rejection further states that it would have been obvious to one of ordinary skill in the art at the time the invention was made that "electronic devices" of this type contain "computer chips" therein for the storage of data (i.e., sounds, songs, and sentences), citing col. 7, lines 36-38 of Hale. Office Action, p. 3, lines 3-5.

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Applicants submit that the present claims overcome the rejection. In order to make out a prima facie case of obviousness, the prior art must teach or suggest all the limitations of the claims. M.P.E.P. 2143 at 2100-129 (8th ed. Rev. 2). As to Claim 1, Hale does not teach or suggest a finger tapper mounted on and extending away from the bottom end of the toy's body where the tapper is movable relative to the body along the direction of a vertical access for actuation of the switch.

The Office Action states that Hale discloses a switch 44 electrically coupled to a computer chip (no numeral cited) and a finger tapper 40 "movably mounted on the bottom end of the body," citing Fig. 2 of Hale and col. 7, lines 45-46. Office Action, p. 2, lines 18-19. Hale teaches a switch, but not a finger tapper extending away from the body and movable relative to the body. In describing Fig. 2, Hale states that for her finger puppet,

tonal button 40, may suitably be mounted in the area indicated by the dotted line image of 42 on the front surface of the paper opposite the finger loop or band 38, with the pressure-sensitive switch portion 44 of the device facing outwardly. Thus, the person can selectively activate the tonal device by pressing it between his fingers, with his thumb on the switch portion 44.

Hale, col. 7, lines 41-48.

Fig. 2 of Hale depicts a switch mounted on the front (facing outwardly) for use by a person who presses it with a thumb in a horizontal direction. Hale does not teach or suggest a finger tapper, or a finger tapper mounted on and extending vertically from the bottom of the toy. Device 44 is a switch, as described by Hale, but it is not a finger-tapper, mounted and movable, as recited in Claim 1. Accordingly, the references do not teach or suggest at least these limitations of Claim 1, which is therefore allowable over the cited art. Claims 2 and 5-10 are also allowable at least because they depend from Claim 1, or from claims depending from Claim 1.

Claim 5

No specific rejection is made for Claim 5, which recites a limitation that the sound generated in Claim 1 lasts for about one to three seconds. Hale does not teach or suggest this limitation, and Claim 5 is therefore also allowable.

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Claim 11

As discussed similarly above for Claim 1, Claim 11 is allowable because Hale does not teach or suggest a switch mounted in the body requiring motion in a vertical direction for activation, and a finger tapper mounted on and extending vertically away from the bottom end of the body. Claims 12-14 and 18-22 are allowable at least because they depend from Claim 11.

Claim 23

Claim 23 is also rejected in view of Hale, but the rejection does not cite specific passages of Hale for specific limitations of Claim 23. As noted above, Fig. 2 of Hale shows the tonal generator and switch on the front or back of the body for actuation by horizontal movement of the thumb, but does not teach or suggest mounting a switch for actuation by a vertical movement. As also noted above, Hale does not show a finger tapper separate from the switch, and thus does not teach or suggest the "finger tapper" limitation. Claim 23 is allowable for at least these reasons, as are Claims 24-28, which depend from Claim 23. The Examiner is respectfully requested to withdraw the rejection of Claims 1, 5-9, 11-14, 18, 20-23 and 25-27 in view of Hale, under 35 U.S.C. § 103(a).

3. Claim 2 depends from Claim 1 and is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,540,132 to Beverly Hale ("Hale") in view of U.S. Pat. No. 3,611,628 to Sid Noble et al. ("Noble"). The rejection states that Hale discloses all the limitations of Claim 1 as discussed above, but does not teach or suggest the Claim 2 limitation that the means for mounting is a ring assembled between the front and the back, and protruding through the back. Noble, states the rejection, teaches such a ring. Noble states that the figurine of Fig. 1-3 has a recess 20 at the rear, and an elastic loop 24 secured to the upper body above recess 20. Fig. 2 shows the loop secured to the back of the figurine, but does not teach or suggest that the loop is assembled between the front and the back. Noble, col. 2, lines 1-7 (emphasis added). The figurine has a belt (no numeral) around its front portion, but Fig. 2 shows clearly that the belt is not part of the elastic loop 24. There is thus no suggestion in Noble that the ring is assembled between a front and a back of the figurine or puppet, as required by Claim

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2. Accordingly, Noble does not teach or suggest a ring assembled between the front and back of the figurine, and Claim 2 is therefore allowable.

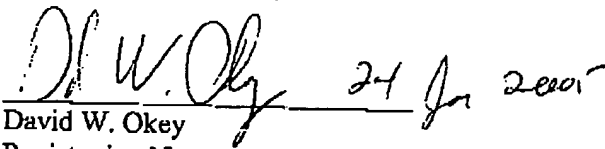
Claim 2 is also allowable because, as discussed above, Hale does not teach or suggest several claim limitations of Claim 1. The Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 103(a) of Claim 2 in view of Hale and Noble.

4. Claim 24 depends from Claim 23 and is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,540,132 to Beverly Hale ("Hale") in view of U.S. Pat. No. 4,295,291 to Osamu Fukui ("Fukui"). The rejection states that Hale discloses the claimed invention except for the head articulably mounted on the body, and that Fukui teaches a head of a toy figure that is articulated. Claim 24 is allowable at least because it depends from Claim 23, which is also allowable.

5. Claims 10, 19, and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,540,132 to Beverly Hale ("Hale") in view of U.S. Pat. No. 5,989,091 to Nicholas Rodgers ("Rodgers"). The rejection states that Hale discloses the invention except for mounting at least one LED on the body and a routine for flashing at least one pattern for the at least one LED, citing Rodgers, col. 3, lines 5-12. Claims 10, 19, and 28 depend respectively from Claims 1, 11 and 23, and are allowable at least because Claims 1, 11 and 23 are allowable.

6. Applicants respectfully request the Examiner to withdraw the rejections and grant allowance of this application. The Examiner is invited to contact the undersigned attorney for the Applicants via telephone if such communication would expedite this application.

Respectfully submitted,


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